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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,304	03/30/2004	Masaaki Nakayama	249-336 (AMK)	1823
23117 7590 09/01/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
AFZAL, SARANG				
ART UNIT		PAPER NUMBER		
3726				
MAIL DATE		DELIVERY MODE		
09/01/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/812,304

Applicant(s)

NAKAYAMA ET AL.

Examiner

SARANG AFZALI

Art Unit

3726

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 10, 11 and 22-26.
Claim(s) withdrawn from consideration: 1-9 and 14-19.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/DAVID P. BRYANT/
Supervisory Patent Examiner, Art Unit 3726

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's amendment to the claim 10 is accepted and as such, the objection to claim 10 for informalities is withdrawn.

As for the rejection of independent claim 10 and dependent claims 11 and 22-26, Applicant mainly argues (Remarks/Arguments, pages 2-4) that the "clay content in an amount of 20-40%" as recited in independent claim 10 is a critical parameter that would obtain superior results and that Applicant has provided this criticality in the claimed range by evidence of surprising and unexpected results as shown with reference to Examples 3B (to establish the lower limit of 20%) and Examples 4B and 5B (to establish the intermediate and maximum limits of 30% and 40%).

Applicant further argues that the maximum amount of specific clay at 40% by weight is a critical parameter that prevents damage to the plate glass while maintaining good wear resistance (Remarks/Arguments, page 3, paragraph 2). In addition, Applicant argues that the Examiner (Response to Arguments, Office Action mailed 5/5/2009) has erred in stating that the Applicant's specification discloses a wide range for each claimed "content range" within which the invention would still perform equally well. In support of this assertion, Applicant refers to Example 6B wherein the clay content was merely changed to 50% which increased the plate glass susceptibility to damage and wear resistance.

The Examiner respectfully disagrees with the above arguments. Note that the Applicant throughout the long prosecution history from originally filed claims on 3/30/2004 through several claim amendments filed on 2/27/2007, 8/10/2007, 8/5/2008 and 9/12/2008 had maintained pending claims wherein the content of the clay present in the disc members was in an amount of 5 to 55% by weight based on the total weight of said disc members (i.e. claims 12 and 18). It wasn't until the claim amendment filed on 1/30/2009 that Applicant decided to cancel claim 12 and amend independent claim 10 to include the "critical" claimed range of 20-40%. Therefore, it is not clear how in the span of 4 1/2 years of prosecution history the critical range of clay content had stayed at 5 to 55% by weight and only in the last six months the criticality has changed to 20 to 40% by weight?

Furthermore, the Applicant, in Table 1, shows that the highest rating mark of "Excellent" is given only to the Examples 4B and 5B for all the three categories of "Wear Resistance", "Followability to Shaft" and "Overall Evaluation." Note that the lower limit of clay content of 20% was only granted one "Excellent" mark for "Followability to Shaft" and two "Good" marks for "Wear Resistance" and "Overall Evaluation." As such, Applicant is asserting that Example 6B (with clay content of 50%) resulting in scratches (2 scratches per 1 square meter of the surface) or other damage to the glass while receiving "Excellent" marks in the categories of "Wear Resistance" and "Followability to Shaft" and a "Good" mark in the "Overall Evaluation" is more undesirable than Example 3B with less favorable ratings. One would think that the lower limit of 20% should receive a higher rating than the 50% limit.

With regards to claims 24 and 25, Applicant only argues that it is not mathematically impossible in Ohshima to have clay contents of particles with claimed particle sizes without providing any evidence to support this assertion.

In view of the above, the rejection of claims 10, 11, and 22-26 as being obvious over Kaiser et al. and in view of Ohshima et al. Asaumi et al. and Yoshida et al. is still valid and maintained.